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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

AGGARWAL, YOGESH K

ART UNIT

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2622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,941	Applicant(s) HIRABAYASHI ET AL.	
	Examiner YOGESH K. AGGARWAL	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

1. The restriction requirement mailed 12/28/2009, has been withdrawn in view of the applicant's arguments to the elected invention. In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005 <<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/og200547.htm>>), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

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In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

3. Claim(s) 13 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 13 and 14 define a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" - Guidelines Annex IV). That is, the scope of the presently claimed program having a recording medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakanishi et al. (US PG-PUB 20040027890).

[Claim 1]

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An image-information recording device (figures 2 and 3), comprising: image-data identifying means (PID identifier, see figure 4 and Paragraph 82) for identifying image data based on predetermined image data units and an image data unit group including the image data units (see figure 4 and Paragraph 82) image-information obtaining means for obtaining image information regarding the image data from the identified image data (Paragraph 82); and image-information recoding means for recording, as image information data, the obtained image information onto a storage medium, wherein the image information data is managed for each data unit on the storage medium (figure 2 shows the information storage).

[Claim 2]

An image-information recording device, comprising: image-data identifying means for identifying image data based on predetermined image data units and an image data unit group including the image data units (PID identifier, see figure 4 and Paragraph 82); image-information obtaining means for obtaining image information regarding the image data from the identified image data (Paragraph 82); and image-information recoding means for recording, as an image-information file group, the obtained image information onto a storage medium, wherein the image-information file group is managed for each data unit on the storage medium (figure 2 shows the information storage).

[Claim 3]

The image-information recording device according to claim 2, further comprising: an image information memory for holding image information; and image-information storing means for storing the obtained image information in the image information memory, wherein the image-information recording means records the image information, stored in the image information

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memory, in the image-information file group on the storage medium (figure 2 shows the image information storage memory and figures 3 and 4 show the information file group).

[Claims 4-6]

The image-information recording device according to claim 2, wherein the image-information file group includes a representative image file that holds predetermined representative images of the image data wherein each representative image is first complete image data of each image data unit and each representative image is an I picture in a front-end VOB of each image data unit (Paragraph 77).

[Claims 7 and 8]

An image-information display device, comprising: attribute obtaining means for obtaining, with respect to image data identified with predetermined image data units and an image data unit group including the image data units, attributes of image information (figure 8 as shown by arrow hs7) for the image data from image information data in which the image information is recorded on a storage medium for each image data unit ; condition inputting means for prompting input of a search condition regarding an attribute of the image information and receiving the input (attributes are required for playback as taught in paragraph and therefore are the condition searching means); condition searching means for searching the attributes of the image information in accordance with the input search condition; condition searching means for searching the attributes of the image information in accordance with the input search condition; representative-image obtaining means for obtaining representative images of the image data for the respective image data units from the image information file group in accordance with a result of the searching performed by the condition searching means; and displaying means for

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displaying a list of the obtained representative images for the respective image data units (figure 9 and Paragraphs 99).

[Claim 9]

The image-information display device according to claim 8, further comprising: an image information memory for holding image information, wherein the attribute obtaining means holds the obtained attributes in the image information memory; the condition searching means searches the attributes held in the image information memory in accordance with the input search condition; the representative-image obtaining means holds the obtained representative images in the image information memory; and the displaying means displays a list of the representative images held in the image information memory (Paragraph 255).

[Claim 10]

The image information display device according to claim 8, further comprising: link-information extracting means for extracting link information indicating relationships between the representative images and the image data from the image-information file group (hs 7); image selecting means for receiving an input of a selected representative image of the displayed representative image list; and image reproducing means for identifying the image data associated with the selected representative image based on the link information and reproducing the image data (Paragraph 255).

[Claims 11-14]

These are method claims corresponding to claims 1, 2, 7 and 8 respectively. Therefore they are analyzed and rejected based upon claims 1, 2, 7 and 8 respectively.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOGESH K. AGGARWAL whose telephone number is (571)272-7360. The examiner can normally be reached on M-F 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571)-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yogesh K Aggarwal/
Primary Examiner, Art Unit 2622